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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SAURAV PAUL, PRATHYUSHA MARRI, and
D. CURTIS DENO

Appeal 2018-003677
Application 13/102,002
Technology Center 3700

Before MICHAEL J. FITZPATRICK, RICHARD H. MARSCHALL, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1, 4–7, 10–15, 17, 20, 21, 23, 26, and 28–31, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the term “Appellant” to refer to “Applicants” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as St. Jude Medical, Atrial Fibrillation Division, Inc. Appeal Br. 4.

CLAIMED SUBJECT MATTER

The claims are directed to a system and method for determining tissue type and mapping tissue morphology. Spec. ¶ 2. Claims 1, 15, and 21 are independent. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method of determining tissue type comprising the steps of:
 - acquiring a value of an electrical parameter between a first electrode electrically coupled with tissue and a second electrode, said electrical parameter comprising at least an impedance magnitude component of a complex impedance between said first and second electrodes, and said electrical parameter corresponds to a position of the first electrode;
 - identifying a tissue type from a plurality of tissue types based on said electrical parameter;
 - determining a location of the tissue based on said position of said first electrode;
 - generating a marker representative of the identified tissue type; and
 - superimposing said marker onto a portion of an image or model of the tissue corresponding to said location.

Appeal Br. 17 (Claims App.).

REJECTIONS

Claims 1, 5, 6, 10–13, 15, 17, 20, 21, 23, 26, and 31 are rejected under 35 U.S.C. § 102(b) as anticipated by Cory.² Final Act. 3.

Claims 4 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cory. Final Act. 12.

² US 2006/0085049 A1, published April 20, 2006 (“Cory”).

Claims 7 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cory and Pearson.³ Final Act. 13.

OPINION

The Examiner finds that Cory discloses all of the limitations of independent claims 1, 15, and 21. *See* Final Act. 3–4, 7–12. The Examiner’s findings rely on and cite to specific disclosures in Cory as corresponding to specific claim limitations. *See id.* In the “Response to Amendment” section of the Final Rejection, the Examiner finds that “Applicant’s amendments and arguments/remarks have been fully considered but are moot in view of the current rejections presented above.” *Id.* at 14. The Examiner further “contends that the Cory reference teaches all claim limitations, at least as broadly as currently recited based on the applicant’s amendments.” *Id.*

Appellant first argues, with respect to claims 15 and 21, that “it is not at all clear how Cory could meet the various claim limitations as the Examiner at p. 7 of the non-final Office action [(dated August 17, 2016) (“2016 office action”)] admits that ‘Cory does not explicitly disclose acquiring/determining an electrical coupling index indicative of a degree of coupling between the electrode and the tissue.’” Appeal Br. 10–11. Based on this alleged admission in the 2016 office action, Appellant asserts that the current anticipation rejection of claims 15 and 21 “is rendered entirely improper.” *Id.* at 11. Appellant next argues that the rejection of all of the independent claims “fail[s] to provide any explanation whatsoever that would assist the Appellant’s understanding of the basis for the rejection

³ US 2003/0130711 A1, published July 10, 2003 (“Pearson”).

because the rejection “generically” cites to paragraphs 107–398 of Cory, which includes over 30 pages of text. *Id.* at 11–12. Appellant also argues that its previous traversals, prior to the 2016 office action, against a combination of Cory with another reference not relied upon in the Final Office Action, were not mooted by the Examiner’s rejections in the 2016 office action. *Id.* at 12–13. In a related argument, Appellant asserts that its previous arguments as to Cory have not been addressed by the Examiner in the Final Office Action. *Id.* at 13–14. Appellant contends that the Examiner’s failure to respond to Appellant’s previous arguments renders the action “arbitrary and capricious.” *Id.* at 14. Appellant also contends that its amendments to the claims do not justify a new ground of rejection, because the Examiner addressed the substance of the current claims in the previous rejection of claim 21. *Id.* at 14–15.

In the Answer, the Examiner finds that “the change in the basis of the rejection was the result of the applicant’s amendments and arguments/remarks filed on 1 /13/2017.” Ans. 15. The Examiner also finds that the “amendments to remove and add limitations to the claims altered the scopes of the claims and were subject to further review and reconsideration, upon which the examiner changes the basis of the rejection in view of the prior art of record.” *Id.* The Examiner also notes that none of Appellant’s arguments in the Appeal Brief amounts to an argument that Cory does not disclose any of the limitations of the rejected claims. *Id.* The Examiner provides further guidance regarding the basis of the rejection “[f]or the sake of completeness,” and finds that

Cory discloses in paragraphs [0196]–[0200] that the electrodes may include an indicator that indicates when sufficient electrical contact is made between the electrodes and skin to indicate

sufficient coupling, thus meeting the broadest reasonable interpretation of an electrical coupling index (either coupled or not sufficiently coupled), and therefore the measured electrical parameter of the complex impedance and coefficient includes an electrical coupling index which indicating it was sufficiently coupled.

Id. As to the citation of 30 pages of text in the rejection, the Examiner finds that this mischaracterizes the rejection, which includes citations to more specific citations, some of which are bolded to show that they are “specifically pertinent to that claim limitation.” *Id.* at 16–17 (noting the bolded citation to Cory ¶¶ 376–384). As to the alleged failure to address Appellant’s previous arguments traversing the non-final rejection, the Examiner finds that “the examiner did not provide a more detailed response to the traversal because the rejection with Cory provided [a] clear and updated rejection which addressed the applicant’s amendments to the claims and thus the new grounds of rejection were sufficient to answer the traversal.” *Id.* at 18. The Examiner also notes that the amendments in question did not merely incorporate limitations from claim 21. *Id.* at 18–19.

Appellant has not apprised us of error in any of the Examiner’s rejections. Importantly, the Examiner correctly notes that Appellant does not support its argument that the independent claims are not anticipated with any substantive arguments that address Cory’s disclosure. Instead, the Appeal Brief sets forth a number of largely procedural arguments based primarily on prior prosecution of the application. *See* Appeal Br. 10–16.

To the extent Appellant’s arguments are appealable,⁴ we find them unconvincing. First, as to the argument based on the Examiner’s alleged

⁴ These issues with the prior examination of the application, and the failure of the Examiner to address Appellant’s previous arguments in the Final

“admission” at a prior point in the prosecution, Appellant does not argue that the Examiner’s current findings that Cory discloses the limitations are in error, or explain the lack of support for the findings on appeal. *See* Appeal Br. 10–11. By not referring to the substance of the Examiner’s current findings related to the limitation in question, Appellant suggests that examiners are forever bound by interpretations of prior art in earlier office actions, and cannot revisit and alter the interpretation and application of the prior art to the claims. Appellant does not cite any legal authority to support such a position, and we decline to adopt it. *See id.*

Second, allusions to arguments made in prior prosecution are insufficient to inform us of the substance of Appellant’s challenges to the specific findings that are part of the Final Office Action on appeal. An Appeal Brief must contain the arguments in support of Appellant’s contention that the Examiner erred in the rejection on appeal, not previous rejections. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant.”). Arguments “not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal.” *Id.* We are not bound to search the record in support of previous arguments made by Appellant prior to the Appeal Brief in an attempt to ferret out arguments that may still apply to the pending claims and rejections on appeal. The obligation to include pertinent substantive arguments in the appeal brief

Office Action, may be petitionable, rather than appealable. For example, MPEP § 1001.02(c) lists petitionable matters such as the “prematureness of final rejection” and “requirements made by the examiners.” MPEP § 1001.02(c); *see also* 37 C.F.R. § 1.182 (allowing petitions to address situations “not specifically provided for”).

certainly applies in the situation here, where the claims have been amended during prosecution since the last substantive arguments by Appellant, and the statutory basis and specific citations in support of the rejections have changed since the 2016 office action in question. If Appellant still maintains that Cory fails to disclose one or more limitations of the rejected claims, it was incumbent upon Appellant to raise those substantive arguments in its Appeal Brief and address the current citations to Cory that the Examiner relies upon, not the Examiner's prior rejections that are not on appeal.

Third, Appellant's complaints regarding the failure of the Examiner to specify the basis for the rejection lack merit. Appeal Br. 11–12. In response to Appellant's argument that the Examiner's citations were insufficient because they included a lengthy cite, the Examiner provided an extensive explanation with further guidance that remains unrebutted on appeal. The Examiner noted the reason for including the citation to extensive text (as pertinent background), noted the other, more specific cites to Cory that Appellant ignores in its Appeal Brief, and identified specific paragraphs within Cory as particularly pertinent. Ans. 15–17 (highlighting Cory ¶¶ 196–200, 376–384 as particularly relevant to the substance of the rejections). Appellant had the opportunity to address the Examiner's further explanation and more specific citations with a Reply Brief, but declined to do so. Further, we do not view the Examiner's citations as so lacking in detail that Appellant was not sufficiently apprised of the basis for the rejections.

Fourth, as to Appellant's argument that the Examiner should have addressed Appellant's previous arguments addressing the Examiner's findings prior to the Final Office Action, the Examiner provides unrebutted

and supported argument that both the scope of the pending claims and the bases for the rejections changed in the Final Office Action. *See* Ans. 18–19. The Examiner’s explanation that a more detailed response to the traversal was unnecessary because the new anticipation rejection based on Cory “addressed the applicant’s amendments” and was “sufficient to answer the traversal” stands unrebutted. *Id.* at 18. By declining to address the specifics of the Examiner’s citations to Cory, we are left with no basis to conclude that the Examiner erred in this assertion.

Further, our own review of the record tends to support the Examiner’s position, as the rejection at issue in the 2016 office action was an obviousness rejection based on Cory and another reference not relied on in the rejection on appeal, not an anticipation rejection based on Cory. *See* Non-Final Action at 5 (dated Aug. 17, 2016). In addition, the Examiner’s citations to Cory are more expansive in the Final Office Action (and the Answer), than in the previous, 2016 office action. *Compare id.* at 5–6, with Final Act. 3–4; *see also* Ans. 15–17. These differences support the Examiner’s position that the updated and more extensive cites and the new rejection may address Appellant’s previous arguments. In any event, as we note above, even if Appellant correctly argues that some of the Examiner’s findings from previous rejections include alleged errors that carry through to the current rejections, Appellant should have pointed out those errors with specificity, supported by evidence and argument, in its Appeal Brief. Appellant did not do that.

Based on the foregoing, we sustain the rejection of the independent claims. Appellant relies on the same arguments with respect to the

dependent claims on appeal, and we therefore sustain the rejections of the dependent claims for the same reason. Appeal Br. 16.

DECISION

We affirm the Examiner's rejections of claims 1, 4-7, 10-15, 17, 20, 21, 23, 26, and 28-31.

DECISION SUMMARY

Claims Rejected	Basis	Affirmed	Reversed
1, 5, 6, 10-13, 15, 17, 20, 21, 23, 26, and 31	§ 102 Cory	1, 5, 6, 10-13, 15, 17, 20, 21, 23, 26, and 31	
4 and 14	§ 103 Cory	4 and 14	
7 and 29	§ 103 Cory, Pearson	7 and 29	
Overall Outcome		1, 4-7, 10-15, 17, 20, 21, 23, 26, and 28-31	

FINALITY AND RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED